

REMARKS

Summary

Claims 1-7, 9-17 and 19-41 stand in this application. Claims 8 and 18 have been canceled without prejudice. Claims 1, 11, 22, 26 and 32 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 11, 22, 26 and 32 in order to facilitate prosecution on the merits.

35 U.S.C. § 102

At page 2, paragraph 2 of the Office Action claims 1, 5, 7, 11, 15 and 17 stand rejected under 35 U.S.C. § 102 as being anticipated by Dyszel – “Hangspring Visor for Dummies” (“Dyszel”). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See* MPEP § 2131, for example. Applicant submits that Dyszel fails to teach each and every element recited in claims 1, 5, 7, 11, 15 and 17 and thus they define over Dyszel. For example, with respect to claim 1, Dyszel fails to teach, among other things, the following language:

removing said preview window in response to a user selection outside of said preview window while said preview window is open.

As correctly noted in the Office Action at page 8, paragraph 6, Dyszel “does not teach...removing said preview window in response to a user selection while said preview window is open.” Consequently, Dyszel fails to disclose all the elements or features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 1. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 5 and 7, which depend from claim 1 and, therefore, contain additional features that further distinguish these claims from Dyszel.

Claim 11 recites features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claim 11 is not anticipated and is patentable over Dyszel for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 11. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 15 and 17 that depend from claim 11, and therefore contain additional features that further distinguish these claims from Dyszel.

35 U.S.C. § 103

At page 3, paragraph 4 of the Office Action claims 22, 26, 28-30, 32, 36 and 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyszel. At page 5, paragraph 5 of the Office Action claims 2-4, 6, 12-14, 16, 23-25, 27, 33-35 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyszel in view of United States Patent Publication Number 2003/0122779 A1 to Martin et al. (“Martin”). At page 8, paragraph 6 of the Office Action claims 8, 9, 18 and 19 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Dyszel in view of United States Patent Number 6,947,158 B1 to Kitamura et al. (“Kitamura”). At page 9, paragraph 7 of the Office Action claims 10, 20, 31 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyszel in view of Martin and further in view of Microsoft Windows & MS-DOS 6 User’s Guide (“Microsoft”). At page 11, paragraph 8 of the Office Action claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyszel in view of Microsoft. Applicant respectfully traverses the rejections, and requests reconsideration and withdrawal of the obviousness rejections.

Applicant has cancelled claims 8 and 18 and has incorporated their subject matter into amended independent claims 1, 11, 22 and 32. Therefore, the obviousness rejections with respect to claims 8 and 18 will be addressed below with respect to amended independent claims 1, 11, 22 and 32.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. *See* MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1-7, 9-17 and 19-41. Therefore claims 1-7, 9-17 and 19-41 define over the cited references whether taken alone or in combination. For example, claim 1 recites the following language, in relevant part:

removing said preview window in response to a user selection outside of said preview window while said preview window is open.

As correctly noted in the Office Action, the above-recited language is not disclosed by Dyszel. According to the Office Action, the missing language is disclosed by Kitamura at column 4, lines 39-43. Applicant respectfully disagrees.

Applicant respectfully submits that Kitamura fails to teach, suggest or disclose the above recited language of claim 1. Kitamura at the given cite, in relevant part, states:

when the user selects “STOP” command, the preview window 30 closes to display the window of the application program for example.

By way of contrast, the claimed subject matter teaches “removing said preview window in response to a user selection outside of said preview window while said preview window is open.”

Applicant respectfully submits that Kitamura, arguably, teaches closing a print preview window when a user selects an option contained inside the window (e.g. selecting the STOP command). Applicant respectfully submits that this is different than

“removing said preview window in response to a user selection outside of said preview window while said preview window is open” as recited in claim 1.

Applicant respectfully submits that the teaching of Kitamura requires a user to select an option contained inside a preview window to remove the window. In contrast, the language of claim 1 provides for removing said preview window in response to a user selection outside of said preview window while said preview window is open. Therefore, Kitamura fails to disclose, teach or suggest the missing language. Consequently, Dyszel and Kitamura, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1. Applicant respectfully submits that Martin and Microsoft also fail to disclose, teach or suggest the missing language.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claim 1 is respectfully requested. Claims 2-10 also are non-obvious and patentable over the cited references, taken alone or in combination, at least on the basis of their dependency from claim 1. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Claims 11, 22 and 32 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 11, 22 and 32 are not obvious and are patentable over the cited references for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejections with respect to claims 11, 22 and 32. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejections with respect to claims 12-21, 23-31 and

33-41 that depend from claims 11, 22 and 32 respectively, and therefore contain additional features that further distinguish these claims from the cited references.

For at least the reasons given above, claims 1-7, 9-17 and 19-41 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejections with respect to claims 1-7, 9-17 and 19-41 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

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Docket No.: 1070P3821
Examiner: Wong, Noble S.
TC/A.U. 2173

It is believed that claims 1-7, 9-17 and 19-41 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present patent application.

Respectfully submitted,

KACVINSKY LLC



John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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